



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
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Michael SUTHERLAND et al.) Confirmation No.: 8007
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U.S. Application No.: 09/161,753) Group Art Unit: 3737
)
Filed: September 29, 1998) Examiner: E. Mercader
)
For: REMOVABLE MEDIA RECORDING)
STATION FOR THE MEDICAL)
INDUSTRY)

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10-18-2

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Commissioner for Patents
Washington, D.C. 20231

TECHNOLOGY CENTER R3700

Sir:

REQUEST FOR RECONSIDERATION

The final Office Action dated August 14, 2002 (Paper No. 11) has been carefully reviewed. Reconsideration of the grounds of rejection is respectfully requested in view of the remarks herein.

Summary of the Office Action

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,272,470 to Teshima. Claims 16-43 have been restricted from the patent application due to the inclusion of terms "proprietary" and "servers."

Restriction of Claims 16-43

The Examiner requires the restriction of claims 16-43 because "[t]he new claims introduce elements such as 'proprietary' and 'servers' which require additional searching in areas

not previously searched.” With respect to the term “servers,” Applicants note (in case plurality is somehow the issue) that the pending claims recite the term “server” not “servers.” Further, Applicants respectfully point out to the Examiner that the claims as originally filed and previously rejected included the term “server.” Accordingly, the recitation of the term “server” can not serve as the basis for restriction as asserted by the Examiner.

With respect to the term “proprietary,” the proper inquiry under the restriction requirement is not whether “additional searching in areas not previously searched” is necessary but whether a “different field of search” is required due to the addition of claims 16-43. MPEP 808.02 recites:

A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims . . . Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The Examiner has not shown that the search areas for “proprietary storage technologies” as recited in Claims 16-43 are not pertinent search areas for the “storage device[s]” recited in claims 1-5, or vice versa. Applicants respectfully request withdrawal of the restriction requirement for Claims 16-43.

Rejection of claims 1-5

In the previous Office Action dated December 4, 2001, claims 1-15 were rejected as clearly anticipated by Teshima, the Office Action stating simply:

Teshima ‘470 teaches all the features of the instant invention including a stand-alone workstation connected to the imaging modalities (See Fig. 1, elements 1-4) and an independent removable medium (see Fig. 1, element 3 and 6), which include a number of saving capabilities including CD-ROM (see Fig. 2, all the

saving capabilities are listed under element 13). Furthermore, the invention includes the DICOM communication system (as indicated by Fig. 1 being connected between element 3 and element 2).

Applicants responded in the Amendment dated February 28, 2002 (re-submitted on May 24, 2002) by identifying the Fig. 1 elements referenced in the Office Action (diagnostic medical imaging modality 1, image server 2, electronic clinical recording system 3, and in-house LAN 4) and stating that “Teshima fails to disclose both the recited standalone computer workstation and the recited removable medium recording station,” and further that Teshima “fails to teach or suggest the four separate storage devices” as recited in claim 1.

Applicants maintain and expand on this position as follows. At the time of the issuance of the December 4 Office Action, independent claims 1 (pending) and 6 (now cancelled) recited, among other things, “a medical scanner,” “a standalone computer workstation,” and, “a removable medium recording system” with claim 6 further reciting, for example, “a communications network” and “a server.” Of the elements 1-4 cited by the Examiner in the December 4 Office Action, Applicants assumed for lack of clarification that the Examiner intended element 1 (diagnostic medical imaging modality) to correspond to the recited “medical scanner,” element 2 (image server) to correspond to the recited “server,” and element 4 (in-house LAN) to correspond to the recited “communications network,” leaving only one element, element 3 (electronic clinical recording system) to correspond to both the recited “standalone computer workstation” and the recited “removable medium recording system.” To anticipate a claim, the reference must teach every element of the claim (MPEP § 2131); element 3 can not be used to teach both the recited “standalone computer workstation” and the recited “removable medium recording system.” The Examiner’s reference to Figure 2 in the new final Office Action does not remedy this situation. Figure 2 is simply an illustration of element 3, the electronic

clinical recording station (col. 6:11-12; col. 7:18-19). Teshima does not teach separate elements corresponding to the recited “standalone computer workstation” and the recited “removable medium recording system.” Accordingly, Teshima does not anticipate independent claims 1 (pending) and 6 (now cancelled).

Further, Teshima does not teach or suggest the four separate storage devices as recited in claim 1. In response to the Examiner’s statement that “there are a number of storage capabilities as listed under element 13 of Figure 2,” Applicants refer the Examiner to the specification, which lists these capabilities *in the alternative* (col. 7:58-67: “As the patient card input/output apparatus 13, an IC card input/output apparatus . . . or CD-ROM input/output apparatus is used in combination with an associated interface card.” (emphasis added)) That is, for 35 U.S.C. §102(e) purposes, only one of these capabilities exists in the disclosed system. Accordingly, Teshima does not teach the four separate storage devices as recited in the present claims. Even if Teshima had not recited these capabilities alternatively, the system as argued by the Examiner would not have disclosed the four recited storage devices at least for the reason that Teshima does not disclose the associated “standalone computer workstation” and the associated “removable medium recording system” as discussed above.

Applicants respectfully assert that the rejection under 35 U.S.C. § 102 (e) should be withdrawn because Teshima does not teach or suggest each feature of independent claim 1. Furthermore, Applicants respectfully assert that dependent claims 2-5 are allowable at least because of their dependence on claim 1 and the reasons set forth above. Reconsideration of the rejections of claims 1-5 is requested.

CONCLUSION

Applicants respectfully submit all pending claims, including claims 16-43, are in condition for allowance. An early notice to this effect is earnestly solicited. Should there be any questions regarding the application, the Examiner is invited to contact the undersigned representative to expedite prosecution. If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested, and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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